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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,247	08/31/2000	John William Alcorn	AUS9-2000-0464-US1	4520
7590	01/29/2004		EXAMINER	VU, TUAN A
Rudolf O Siegesmund Suite 2000 4627 N Central Expressway Dallas, TX 75205-4022			ART UNIT	PAPER NUMBER
			2124	6

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/653,247	ALCORN, JOHN WILLIAM
	<b>Examiner</b>	<b>Art Unit</b>
	Tuan A Vu	2124

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 November 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 12-21 (claims 1-11, 22-23 cancelled) is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 12-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) Interview Summary (PTO-413) Paper No(s) 6.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

1. This action is responsive to the application filed August 31, 2000.

Claims 1-11, 22-23 have been cancelled and claims 12-21 are pending in the examination.

### *Drawings*

2. A copy of a set of formal drawings were filed in this application and the office had acknowledged receipt of this set of drawings ( filed 4/09/01). However, this set has been misplaced and not found on file. Examiner would appreciate if Applicants can effect a resent of these. The requirement for corrected drawings will not be held in abeyance.

### *Claim Objections*

3. Claim 12 is objected to because of the following informalities. The element recited as ‘the invocation of a custom finder method’ (line 1) needs to be corrected to become – [the] an invocation of a custom finder method—because this element has been mentioned for the first time. Appropriate correction is required.

4. Claims 12 and 15 are objected to because the recited acronyms such as ‘FH’ (claim 12, line 2) and ‘CB’ ( claim 15, line 2) are not introduced in full spelled-out form for at least once.

### *Claim Rejections - 35 USC § 101*

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12-21 are rejected under 35 U.S.C. 101 because the claims are directed to non-statutory subject matter. The claims are non-statutory because they recite an abstract idea without any practical application.

The Federal Circuit has in recent decisions applied the practical application test in determining whether the claimed subject matter is statutory under 35 USC 101. The practical application test requires that a “useful, concrete, and tangible result” be accomplished. See *AT&T Corp. v Excel Communications, Inc.*, 172 F. 3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 ( Fed. Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F. 3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998). An “abstract idea” when practically applied is eligible for a patent. The Court in *State Street*, 149 F. 3d at 1374, 47 USPQ2d at 1601 noted that “a process, machine, manufacture, or composition of matter employing a law of nature, natural phenomenon, or abstract idea is patentable subject matter even though a law of nature, natural phenomenon, or abstract idea would not, by itself, be entitled to such protection.

Claim 12 appears to recite a method using a FH class comprising 7 structural steps (e.g. *delegating, iterating, adding ... narrowing*), but each of the recited step amounts to nothing more than a name. There is no description as to what action has been performed upon what entities such that it can enable one skilled in the art to have a clear concept on how these steps put together can generate a concrete result. Absent any detail on how those steps are being performed so that a concrete result can be generated, there would be also no tangible result and nor is there an useful result/product being generated within any technological arts.

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As per claims 13-21, these claims recite details further specifying the steps recited in claim 12; but in spite of such specifications, these claims do not describe actions leading to a concrete, tangible and useful result in any technological arts.

Thus, the claims only recite an abstract idea without any practical application in the technological arts, and therefore are non-statutory.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 12-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 14, 15, 16 and 17 recite elements ‘said invoking step’ (line 1 of claims 14-15) or ‘the invoking step’ (line 2 of claim 16-17). There is insufficient antecedent basis for this limitation in the claims. The examiner would interpret this ‘invocation step’ as if it were a step during claim 12 when a custom finder method has been invoked.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete. The claim recites a method using a FH class which is comprising of steps of delegating, iterating, adding ... narrowing; but does not recite on which entities those steps are performed besides the name of the step.

Claim 13 and 19 is rejected because they recite the element ‘the Tie’ ( line 2). There is insufficient antecedent basis for this limitation in the claims.

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Claim 14 is rejected because it recites the element ‘the underlying application server’ (line 2). There is insufficient antecedent basis for this limitation in the claim.

Claim 15 is rejected because it recites the element ‘the IQueryableIterableHome class’ (line 3). There is insufficient antecedent basis for this limitation in the claim.

Claims 18 and 20 are rejected because they recite the elements ‘the Vector class’ (line 2 claim 18) and ‘the portable Enumeration class’ (line 2, claim 20). There is insufficient antecedent basis for these limitations in the claims.

Claim 21 is rejected because it recites the element ‘the standard PortableRemoteObject.narrow()’ (line 2). There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102 or 35 USC § 103***

8. In view of the USC 35 112 rejection as set forth above, Examiner has not been able to have substantial information or clues from the independent claim in order to start a reasonable interpretation for what is being claimed; or to establish elements against which to apply prior art. Raised will be questions as to what executing context is this claimed method established under, and what action has been taken in such specificity as to yield a result from or to relate to the method claimed as invoking a ‘FH class’. Therefore, no prior art rejection can be established.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan A Vu whose telephone number is (703)305-7207. The examiner can normally be reached on 8AM-4:30PM/Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (703)305-9662.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9306 ( for formal communications intended for entry)

**or:** (703) 746-8734 ( for informal or draft communications, please label  
“PROPOSED” or “DRAFT”)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA. , 22202. 4<sup>th</sup> Floor( Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the receptionist whose telephone number is (703) 305-3900.

VAT  
January 6, 2004

*Kakali Chaki*

KAKALI CHAKI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100